

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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FAVORED TECH CORPORATION,

Petitioner

v.

P2I LTD.,

Patent Owner

Case No. IPR2020-01198

Patent No. 10,421,876

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**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO  
PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
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Petitioner's Reply confirms that the Petition is deficient for not having addressed whether any of Cohen, Holliday, Francesch and Tropsch is analogous art. *In re Bigio*, 381 F. 3d 1320, 1325 (Fed. Cir. 2004) ("References . . . qualify as prior art for an obviousness determination only when analogous to the claimed invention."). The Reply still fails to meet Petitioner's threshold burden of proof in this regard, and fails to show that its 5 grounds are not redundant. Accordingly, the Board should deny institution of trial.

**I. FOUR OF FIVE GROUNDS RELY ON NON-ANALOGOUS ART**

*Donner Technology, LLC v. Pro Stage Gear, LLC*, No. 2020-1104 (Fed. Cir. Nov. 9, 2020), fails to justify Petitioner's Reply, as it did not change the law regarding analogous art and does not support that the four asserted secondary references here are within the field of endeavor of the '876 patent, or are reasonably pertinent to the problem with which the inventors were involved. The Reply does not address the facts of *Donner* or the Court's actual holding that "[b]ecause the Board failed to identify and compare the problems to which the '023 patent and Mullen [prior art reference] relate, the Board failed to apply the proper standard." *Donner*, slip op. at \*10, \*12. P2i plainly identified the problems that the '876 patent addresses and showed that each of the secondary references addresses different problems and solutions which are not reasonably pertinent. Petitioner simply ignored these issues altogether. *cf. Donner*, slip op. at \*8 (observing that the Petitioner

submitted detailed expert testimony and argument in its petition relevant to the inquiry.) Furthermore, the concern mentioned in *Donner* of defining the problem so as to effectively exclude references outside the field is not implicated here. The problems addressed by the '876 patent do not necessarily preclude all references outside the field from being pertinent. They do preclude the 4 asserted secondary references, which teach nothing relevant to those problems.

The analogous art requirement limits the pertinent art to the fields which a POSA "would reasonably be expected to look for a solution to the problem facing the inventor." *In re Oetiker* 977 F.2d 1443, 1447 (Fed. Cir. 1992). "To determine the applicable field of endeavor, the factfinder must consider 'explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention.'" *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1380 (Fed. Cir. 2019)(citing *Bigio*, 381 F.3d at 1325.)

Petitioner ignores the thrust of the '876 patent's teachings and invites error by overbroadly characterizing the field of the '876 patent as "polymer coatings." However, simply devising a field broad enough to encompass both the asserted art and the invention is improper. See *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). First, this characterization is inconsistent with the '876 patent, which reveals through the specification, embodiments, and claims that the field of the endeavor relates solely to *plasma* polymerized *protective* coatings. POPR at 42-43; Ex. 1001 at

18:26–36: reciting “a protective cross-linked polymeric coating . . . obtained by exposing said device or component to a plasma. . . .”; 1:5–13: “the present invention relates to protective coatings for electronic or electrical devices . . .”; 15:40–18:23: each example 1-6 describing plasma polymerized protective coatings.

Petitioner's expert did not assert that the field is as broad as now alleged in the Reply. She acknowledged that “the [‘876] patent discusses crosslinked plasma polymer coatings applied to electronic devices” and notes that the only specialized experience a POSA would have is “at least two years of experience with *plasma* polymerization techniques.” Ex. 1002 ¶¶29, ¶59 (emphasis added.) A POSA would know that “plasma polymerization is a new material preparation process and is not a kind of polymerization”, and that the coatings formed by plasma polymerization are “vastly different from conventional polymers.” Ex. 2001 ¶37; Ex. 2002 ix; Ex. 1002 ¶36: recognizing plasma polymerization as distinct from molecular polymerization. A POSA would not be expected to look to references directed to conventional polymerization processes when looking to solve problems related to creating protective coatings using a plasma polymerization process. Ex. 2001 ¶¶37-40; *See Airbus S.A.S.*, 941 F.3d 1374, 1381 (Fed. Cir. 2019)(finding knowledge of a POSA relevant to scope of the field of endeavor.)

Petitioner even fails to show that each of the asserted references is in the “polymer coatings” field. Cohen instead relates to dielectric materials and filling

compounds for use in devices such as capacitors and cable joints. Ex. 1006 5:1-21. Tropsch relates to preparing polymers comprising peroxy-carboxyl groups having applications in bleaches, disinfectants, and cleaners. Ex. 1011 1:26-33; 5:60-6:21. The other references are irrelevant to plasma polymerized protective coatings. Francesch relates solely to plasma-derived coatings for bioactive surfaces. Ex. 1009 605-606, 610. Holliday relates to curable dip coatings for electrical connectors and other conductors. (Ex. 1007 at 1:12–15, 1:23–25, 1:52-2:35, 2:60–64.)

Petitioner fails to conduct any analysis regarding reasonable pertinency, in which “the problems to which both [the asserted reference and the claimed invention] relate *must* be identified and compared.” *Donner*, slip op. at \*8 (emphasis added.) Petitioner instead argues the *explicit* description of the problems addressed in the ‘876 patent, which relate to improving the quality and plasma processing range of plasma-derived protective coatings for electronics (Ex. 1001 1:5-13; 1:20-33; 57-67; 2:1-7), “could not possibly be a relevant purpose of the invention” because these problems were allegedly “already solved by known coatings.” This argument fails because the ‘876 patent does not state that the identified problems are solved by known coatings, such as those made with PFAC8. Ex. 1001 1:24-27: stating water contact angle of PFAC8 coatings are “compromised”; *see Donner*, slip op. at \*8-9.

Petitioner then argues that ‘876 patent’s purpose relates “to achieving highly crosslinked coatings at low power.” This assertion defeats Petitioner’s own

argument. Achieving highly crosslinked coatings at low power is a problem specific to plasma polymerization, and not polymerization in general. Petitioner does not even allege that any of the 4 asserted references address how to achieve highly crosslinked coatings at low power, and of course, they do not. (POPR 42-48.)

Accordingly, Petitioner fails to establish that the pertinent field is “polymer coatings” or that a POSA would have looked to any of the four non-analogous references to address the problems facing the inventors of the ‘876 patent, which are unique to forming plasma polymerized protective coatings.

## **II. PETITIONER FAILS TO JUSTIFY ITS REDUNDANT GROUNDS**

Petitioner asserts that its 5 redundant grounds are allegedly necessary to “address all claimed crosslinkers.” But this explanation still fails to address why 5 grounds are necessary when each of the 15 claims are challenged with only grounds 1 and 2.

Ground	Claims	Basis for Unpatentability
Ground 1	1-3, 9, 11-15	Obvious over Coulson-122, Badyal, and Cohen
Ground 2	1-8, 10-15	Obvious over Coulson-122, Badyal, and Holliday
Ground 3	1-4, 10, 12-15	Obvious over Coulson-122, Badyal, and Padiyath
Ground 4	1-3, 5-8, 11-15	Obvious over Coulson-122, Badyal, and Francesch
Ground 5	1-3, 5-8, 12-15	Obvious over Coulson-122, Badyal, and Tropsch

Because it presents excessive grounds without a reasonable justification, and relies on non-analogous art for 4 out of 5 grounds, the Petition should be denied.

Respectfully submitted,  
FITCH EVEN TABIN & FLANNERY LLP

Dated: December 8, 2020

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a true copy of the foregoing paper was served this 8th day of December, 2020, by e-mail upon the following:

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Petitioner has consented to service by electronic means.

Respectfully submitted,  
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